

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

SOLID STATE LUMINAIRES, L.L.C.)
)
Plaintiff,)
)
v.)
)
TIVOLI, L.L.C.) Court No.
)
Defendant.)

COMPLAINT FOR DAMAGES AND INJUNCTIVE RELIEF

NOW COMES the Plaintiff, SOLID STATE LUMINAIRES, L.L.C., an Illinois limited liability company ("SSL") by and through its attorneys, Alan R. Lipton and Kourtney A. Mulcahy of HINSHAW & CULBERTSON, LLP, and for its Complaint for Damages and Injunctive Relief against Defendant TIVOLI, L.L.C. ("TIVOLI"), states as follows:

THE PARTIES

1. SSL is an Illinois limited liability company with its principal place of business in St. Charles, Illinois. It is in the business of manufacturing and distributing LED lighting fixtures and offers a complete line of LED lighting based products.
2. TIVOLI is a California limited liability company with its principal place of business in Tustin, California. It is in the business of manufacturing and distributing LED lighting fixtures and offers a complete line of LED lighting based products.

JURISDICTION

3. This Court has jurisdiction over the subject matter pursuant to 28 U.S.C. § 1331, in that this action involves questions of federal law pursuant to 28 U.S.C. § 1338(a) and 1338(b) involving federal claims for unfair competition and false designation of origin.

4. This Court has supplemental jurisdiction over the state law claims pursuant to 28 U.S.C. § 1337(a).

VENUE

5. Venue is proper in this district pursuant to 28 U.S.C. 1331(b) (2) since a substantial part of the events giving rise to the claims occurred in this judicial district.

FACTUAL BACKGROUND

6. In or about September 2010, SSL began using the trademark COVELINE in interstate commerce in connection with one of its lines of LED lighting fixtures. SSL has been using the mark COVELINE continuously in interstate commerce as a source identifier since at least as early as the aforementioned date.

7. On or about November 9, 2010, SSL sold its first COVELINE product. Attached hereto as Exhibit "A" and incorporated by herein by this reference is a true and correct copy of SSL's invoice of said date.

8. On or about November 15, 2010, SSL began using the mark COVELINE on its website to promote its line of LED lighting fixtures under that mark.

9. Since 2010, SSL has advertised and promoted its COVELINE products nationally on the internet. Since at least 2010, SSL has advertised and promoted its COVELINE products through product catalogs, trade publications, billboards, and national tradeshows. Attached hereto as Exhibit "B" and incorporated herein by this reference is a true and correct copy of the first and sixth page from the 2010 product catalog that features new SSL products for 2011, which includes the COVELINE product line.

10. Since it first began using the COVELINE mark in 2010, SSL has spent tens of thousands of dollars on advertising and promoting its COVELINE products.

11. Since 2010, SSL has sold over 10,000 products bearing the COVELINE mark throughout the United States, including Illinois and California, as well as internationally.

12. FC Lighting, Inc. ("FC Lighting") is an Illinois corporation with its principal place of business in St. Charles, Illinois. It is in the business of manufacturing and distributing a variety of lighting fixtures, including but not limited to, LED, fluorescent, recessed and incandescent lighting products and offers a complete line of each of these lighting based products. FC Lighting and SSL share common ownership. Often times, FC Lighting and SSL attend the same tradeshows and promote each of their products at the same booth at those tradeshows.

13. Beginning on or about May 17, 2011, both SSL and FC Lighting attended the three (3) day LightFair International Conference in New York City. FC Lighting was an Exhibitor and had a booth at this conference. Attached hereto as Exhibit "C" and incorporated herein by this reference is a true and correct copy of the LightFair International 2011 List of Exhibitors, which identifies FC Lighting as an Exhibitor.

14. During this conference, SSL promoted its COVELINE product line at the FC Lighting booth and distributed its new products catalog for 2011, which features the COVELINE products. Attached hereto as Exhibit "D" and incorporated herein by this reference is a true and correct copy of a SSL handout distributed at the FC Lighting booth during the LightFair Conference.

15. Upon information and belief, on May 18, 2011 TIVOLI was a Presenter at the LightFair Conference discussing the topic "How We See Color" during an educational session. Attached hereto as Exhibit "E" and incorporated herein by this reference is a true and correct copy of a March 1, 2011 webpage from TIVOLI's website stating that it would be a Presenter at the conference.

16. On or about May 23, 2011 – four days **after** the Light Fair Conference - TIVOLI filed its federal trademark application for COVELINE under §1(b) of the Trademark Act, 15 U.S.C. §1051(b)(1). This section of the Act is used to provide protection to marks that have not yet been used in commerce but only where the person registering the mark has a "bona fide intention...to use a trademark in commerce..." Attached hereto as Exhibit "F" and incorporated herein by this reference is a true and correct copy of said trademark application

17. On or about June 28, 2013, TIVOLI, through its counsel, sent SSL a cease and desist letter for alleged trademark infringement of the mark COVELINE. Attached hereto as Exhibit "G" and incorporated herein by this reference is a true and correct copy of said cease and desist letter.

18. The cease and desist letter (Exhibit "G") encloses a copy of TIVOLI's U.S. Certificate of Registration for the mark COVELINE in connection with electronic lighting fixtures. The Certificate identifies the date of first use for this mark in interstate commerce as June 15, 2011 – at least nine (9) months **after** SSL began using its COVELINE mark for LED lighting fixtures.

19. TIVOLI's use of the mark COVELINE for its LED lighting fixtures infringes upon SSL's mark COVELINE in that they are the exact same mark, used in the same or similar channels of trade and likely to cause confusion regarding the source of the goods at issue, or as to affiliation, relationship, or sponsorship by SSL of TIVOLI.

20. SSL has superior rights in the COVELINE mark as it used the mark in interstate commerce for its LED products prior to TIVOLI's first use of its mark COVELINE for its LED products.

21. TIVOLI's use of the mark COVELINE and its registration of that mark with the United States Patent and Trademark Office has been willful and in violation of SSL's superior

common law rights in interstate commerce and has forced SSL to incur attorneys' fees to protect its intellectual property rights in its mark.

FIRST CLAIM FOR RELIEF

(False Designation of Origin, 15 U.S.C. § 1125(a))

22. SSL adopts and realleges paragraphs 1-21, inclusive.

23. SSL has been using the mark COVELINE for its LED lighting fixtures since at least as early as the Fall 2010 on the internet and across state lines in its promotional materials.

24. TIVOLI's use of the trademark COVELINE, along with its registration of that mark with the federal government, is likely to cause confusion, mistake, or to deceive as to the affiliation, connection or association of TIVOLI with SSL, or as to the origin, sponsorship, or approval of TIVOLI's products.

25. TIVOLI's registration and its use of the mark COVELINE constitutes a false designation of origin in violation of §43(a) of the Lanham Act (15 U.S.C. § 1125(a)).

26. TIVOLI's registration and its use of the mark COVELINE constitutes a false or misleading description or representation in violation of § 43(a) of the Lanham Act (15 U.S.C. §1125(a)).

27. TIVOLI's registration and its use of the trademark COVELINE has caused substantial and irreparable harm, damage and injury to SSL and will continue to cause such harm, damage and injury to SSL unless TIVOLI's use of its mark is preliminarily and permanently enjoined and its registration of that mark cancelled.

28. Because of TIVOLI's willful, deceptive, and intentional acts, SSL demands an award of its attorneys' fees.

SECOND CLAIM FOR RELIEF

(State Claim – Common Law Trademark Infringement)

29. SSL adopts and realleges paragraphs 1- 28, inclusive.
30. TIVOLI's registration and use of the mark COVELINE is likely to cause confusion as to whether or not TIVOLI is affiliated with, connected with, or sponsored by SSL.
31. TIVOLI's conduct has caused substantial and irreparable harm, damage and injury to SSL in that customers seeking information about COVELINE are likely to believe that TIVOLI is linked, affiliated, connected, sponsored or otherwise related to SSL.
32. TIVOLI's conduct will continue to cause such irreparable harm, damage, and injury to SSL unless TIVOLI is preliminarily and permanently enjoined from using the mark COVELINE or any other confusingly similar name or mark thereto.

THIRD CLAIM FOR RELIEF

(State Claim – Violation of the Illinois Uniform Deceptive Trade Practices Act – 815 ILCS § 510)

33. SSL adopts and realleges paragraphs 1-32, inclusive.
34. The foregoing acts of TIVOLI are in violation of the Illinois Uniform Deceptive Trade Practices Act, 815 ILCS § 510.
35. Because of TIVOLI's willful, deceptive and intentional acts, SSL demands an award of its attorneys' fees.

FOURTH CLAIM FOR RELIEF

(State Claim – Consumer Fraud – 815 ILCS § 505)

36. SSL adopts and realleges paragraphs 1-35, inclusive.
37. The foregoing acts of TIVOLI are in violation of the Illinois Consumer Fraud Act, 815 ILCS § 505.

38. Because of TIVOLI's willful, deceptive and intentional acts, SSL demands an award of its attorneys' fees.

PRAYER FOR RELIEF

WHEREFORE, SOLID STATE LUMINAIRES, L.L.C. requests that this Court enter judgement in its favor and against TIVOLI, L.L.C. on the claims herein and that this Court:

- (1) Preliminarily and permanently enjoin TIVOLI and its employees, agents and servants, and any person in active concert with them from using the mark COVELINE or any other trademark, service mark, trade name or domain name which is confusingly similar thereto;
- (2) Order TIVOLI to account to SSL for any and all profits derived from TIVOLI's sale of falsely designated goods;
- (3) Award SSL the profits of TIVOLI together with all damages it has sustained as a result of TIVOLI's infringing activities, according to proof and that said damages be trebled pursuant to § 15 U.S.C. § 1117(a);
- (4) Award SSL punitive and/or exemplary damages, according to proof;
- (5) Award SSL its reasonable attorneys' fees;
- (6) Award SSL its costs of this action along with prejudgment and post-judgment interest;
- (7) Cancel the U.S. Certificate of Registration issued for the mark COVELIN in the name of TIVOLI, L.L.C; and
- (8) Award SSL such other and further relief as this Court deems just and proper in the premises.

SOLID STATE LUMINAIRES, L.L.C. DEMANDS TRIAL BY JURY.

Respectfully submitted,

HINSHAW & CULBERTSON LLP

By: s/s Kourtney A. Mulcahy
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